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Application Number	10/648,955
Filing Date	08/27/2003
First Named Inventor	Bennett M. Richard
Art Unit	3672
Examiner Name	Giovanna M. Collins
Attorney Docket Number	D5407-188

Total Number of Pages in This Submission

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Remarks

Filed herewith in triplicate is Appellant's Reply Brief.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Duane Morris LLP		
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Bennett M. Richard, et al.	§	Examiner:	Giovanna M. Collins
		§		
Serial No.:	10/648,955	§	Group Art Unit:	3672
		§		
Filing Date:	August 27, 2003	§	Attorney Docket No.:	D5407-188
		§		
Title:	Telescoping Centralizers for Expandable Tubulars	§		

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APPELLANT'S REPLY BRIEF

I. Reply to Examiner's Argument

a) Campbell USP 6,112,818

To quote a line from the movie Cool Hand Luke, "what we have here is a failure to communicate."

The Examiner first states that claim 1 doesn't define where delivery ends. The argument then builds that delivery could happen as the string 16 in Campbell is run in and then the bow spring centralizer could enter the wellbore to centralize after the delivery.

The response to this argument begins with looking at the prosecution history. Claim 1 was amended to add the phrase "after said delivering" to get around prior art. The argument made at that time, in view of Maguire, included the following sentence:

"Accordingly claim 1 now reflects that the tubular is delivered into the wellbore and then positioned after delivery in a manner that leaves an annular space around it."

According to www.dictionary.com , delivery means: the act of conveying or delivering; or something delivered, as a shipment or package.

"After" according to the same source means: Subsequent in time to; at a later time than: *come after dinner.*

So what this file wrapper shows is nothing less than an estoppel by amendment and argument that positioning occurs when delivery is over. Using the common meaning of the terms from a dictionary, the result is the same. This claim positions a tubular after it is in its desired position downhole, i.e. delivered.

Claim 1 is clearly an oilfield application where those skilled in the art will realize that delivery is simply another term for running in.

The Examiner's focus on the term delivery and what it could mean standing alone is misplaced in that such analysis ignores the presence of the term "after." When those terms are put together the only meaning that is logical and clear is that there is no positioning going on until after delivery is over. There is simply no plainer way to say it.

The Examiner's fallback position is that even if delivery means fully running in the tubular to the desired position, Campbell's bow spring centralizer 17 still positions the tubular in the wellbore. This is incorrect. The tubular in the claim has to be moved after it is fully delivered. A bow spring centralizer centralizes on the way down. When delivery ends, nothing happens by virtue of the presence of the bow spring centralizer. The tubular simply holds the position it has because of the centralizer. The claim requires an action to occur after the tubular is delivered. A bow spring centralizer is a passive device that depends on tubular movement to do its job. Stop the advance of the tubular and the bow spring centralizer is incapable of positioning the tubular. Claim 1 requires the tubular to be movable in a manner that leaves an annular space around it after its movement into the hole has stopped. A passive bow spring centralizer can't do that.

On the top of page 5 the Examiner again argues that claim 1 does not preclude positioning during delivery. Again, the Examiner ignores the file wrapper and the amendment to claim 1 and the argument presented with that amendment which clearly and unambiguously state that what is claimed is only positioning after conclusion of delivery.

The Examiner points to Campbell item 48 as a centralizer that will position the tubular after delivery. Item 48 is a gap in one of the swage cones 30 or 40 that is part of the assembly 12 shown in Figure 3. Item 12 is disposed inside the tubular to be expanded 14. Because of its placement inside the tubular it can do nothing to position it after delivery. What the swages can do after delivery is simply expand the tubular. Claim 1 requires positioning in a manner to leave an annular space around the tubular. Clearly, an internal swage can do nothing of the kind.

b) Chatterji USP 6,543,545

Here the Examiner simply repeats the Campbell analysis.

c) Chatterji USP 6,543,545 in view of Wilson USP 5,228,518

In making a case that these two references can be combined to base a rejection for obviousness, the Examiner's rational is lacking context to the elements of claim 1. What claim 1 is not is a method of positioning a tubular after it is delivered and that's all. Rather, the claim positions a tubular after it is delivered in the context of expansion of the tubular which logically must follow positioning it. Thus, put into the proper context of all the claim elements, these references teach away from each other in several respects.

Wilson has no teaching that a tubular that is positioned after delivery is so positioned because it will then be expanded. Clearly the step of expansion that is in claim 1 would have some interplay to the technique for positioning. The base reference Chatterji does absolutely no positioning after delivery at all. It does do expansion after delivery. The Wilson reference has no bearing to expansion. For that reason the structures

it teaches for positioning are not useful to one skilled in the art who contemplates expansion after delivery and positioning. The fact that Wilson eschews bow spring centralizers misses the point. Bow spring centralizers are an exterior structure to the tubular during run in and are passive devices. Yet the Examiner takes the position that actively operated pistons that are internal during delivery and later get actuated are readily interchangeable concepts, which they are not.

Not only do these references position in different ways, one passively positions during delivery and the other actively positions after delivery. One expands after delivery without any positioning after delivery and the other only positions after delivery without any expanding. Clearly one of ordinary skill in the art trying to develop the invention of claim 1 would have a harder time forcing the technology of these two references together than starting with a blank slate. It appears the Examiner simply is picking bits and pieces from divergent references to come up with the invention of claim 1 using hindsight of the knowledge of the claim 1 invention.

d) **Maguire US Application 2003/0047322**

This is clearly the least understandable reference to reject the claims. It simply shows insertion of one tubular in another and then advancing a roller expander through the inner tubular to expand it into contact with the surrounding tubular. The Examiner makes no reference to the specification of Maguire to support the position taken. The Examiner makes up a reason to reposition in this reference that relates to being able to insert the roller expander. The fact is the roller expander 100 has retractable rollers 116 when it is run inside the tubular to be expanded. Claim 1 deals with positioning after

delivery to leave an annular space around it. In Maguire the positioning is irrelevant because the operation of the roller expander will expand the inner tubular against the outer tubular regardless of the initial position of the inner tubular with respect to the outer tubular. There is not one sentence of discussion in Maguire that positioning after delivery helps in being able to advance the roller expander with retractable rollers. The four corners of this reference do not even begin to anticipate the claimed method.

Respectfully submitted,

05/08/2006

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Tracie Thigpen